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EXAMINER

LUONG, VINH

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 19

Application/Control Number: 09/600,832
Filing Date: July 21, 2000
Appellant: GIEFER

MAILED

DEC 02 2002

Theobald Dengler for
Appellant

GROUP 3600

EXAMINER'S ANSWER

This is in response to appellant's Brief on appeal filed September 11, 2002.

(1) Real Party in Interest.

The statement of the real party in interest is contained in the brief.

(2) Related Appeals and Interferences.

The statement of the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of claims.

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 18-30, 32, 33, and 35-38.

(4) Status of Amendments After Final.

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The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The amendment after final rejection filed on August 21, 2002 has not been entered. The amendment after final rejection filed on September 11, 2002 with the Brief to cancel claim 31 has been entered. Since claim 31 has been canceled, therefore, appellant's statement regarding the status of claims is incorrect as seen above.

(5) Summary of invention.

The summary of invention contained in the brief is correct.

(6) Issues.

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: appellant's issues (1) - (3) are correct. However, appellant's issues (4) - (6) relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

(7) Grouping of claims.

Appellant's brief includes a statement that claims 18-30, 32, 33, and 35-38 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims appealed.

A correct copy of appealed claims 18-30, 32, 33, and 35-38 appears on pages 24-26 of the Appendix to the appellant's brief.

(9) Prior Art of record.

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The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

DE 197 28 548 A1 ANDRONIS (Fed. Rep. of Germany) 3-1998

(10) *New prior art.*

No new prior art has been applied in this examiner's answer.

(11) *Grounds of rejection.*

The following grounds of rejection are applicable to the appealed claims:

(A) claims 18-30, 32, 33, 35, and 38 are rejected under 35 U.S.C. 112, first paragraph.

This rejection is set forth on page 5 of the final rejection on March 11, 2002 (Paper No. 9);

(B) claims 18-30, 32, 33, and 35-38 are rejected under 35 USC 112, second paragraph. This rejection is set forth on pages 5 and 6 of Paper No. 9; and

(C) claims 18-21, 24, 26-29, 36, and 37, as best understood, are rejected under 35 USC 102(a) as being anticipated by Andronis (DE 197 28 548 A1 cited as an X category reference in the Search Report of appellant's corresponding PCT application). This rejection is set forth on pages 6-9 of Paper No. 9.

(12) *New ground of rejection.*

This Examiner's Answer does not contain any new ground of rejection.

(13) *Response to argument.*

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The examiner's response to appellant's arguments in Paper No. 9 is incorporated herein by reference. In the following, the examiner responds to appellant's new arguments that had not been addressed in Paper No. 9.

1. Whether appellant's claims 18-21, 24, 26-29, 36, and 37 are unpatentable under 35 USC 102 by Andronis?

For appellant's convenience, the examiner responds to appellant's issues in accordance with appellant's order as presented.

Claim 36

At the outset, appellant asserts that the element 3 of Andronis is not similar to the louver of the present invention. However, if one compares, *e.g.*, appellant's Fig. 2 and Andronis' Fig. 4, one should recognize the similarity between Andronis' element 3 and appellant's element 2 as both being a closed loop with an opening for a selector lever, hence, they are the so-called "louver" in appellant's claims. Appellant wrongly uses an "*ipsissimis verbis*" test that requires the same terminology in the prior art in order to find anticipation. See footnote 11 in *AKZO N.V. v. International Trade Commission*, 1 USPQ2d 1241, 1245 (CAFC 1986). In the instant case, Andronis does not need to use appellant's lexicography such as "a louver" to anticipate appellant's claims. It is well settled that anticipation law requires distinction be made between invention described or taught and invention claimed. It does not require that the reference "teach" what subject patent application teaches, it is only necessary that the claim under attack, as construed by the Court, "*read on*" something disclosed

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in the reference, *i.e.*, all limitations of the claim are found in reference, or are “*fully met*” by it. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781, 789 (CAFC 1983).

Second, appellant contends that if the element 38 of Andronis is equated with the louver guide of claim 36, the element 38 of Andronis would not be movably connected to elements 14 and 15 in the same relationship as the louver and louver guide in claim 36. Contrary to applicant’s subjective conjecture, Fig. 4 of Andronis shows that the lever 6 is connected to the band 3 or 38 by the universal joint 14 and 15, therefore, when the lever 6 is moved in multiple directions, the band 3 or 38 is moved therewith as claimed in claim 36 and shown in the Exhibit attached to Paper No. 9.

Third, appellant contends that Andronis’ element 14 appears to be fixed to element 38 or 44, therefore, it does not have the movable feature. However, appellant overlooks the fact that the element 14 is also fixed to the lever 6, *a fortiori*, the element 14 is moved with the lever 6. Note that an anticipatory reference needs not duplicate word for word what is in the claim. Anticipation can occur when a claimed limitation is “inherent” or otherwise implicit in the relevance reference. *Standard Haven Products, Inc. v. Gencor Industries, Inc.*, 21 USPQ2d 132, 1328 (CAFC 1991). Andronis’ elements 14, 15, 39-41 are equated to the louver guide in claim 36 since these elements operate similarly as appellant’s rollers 3.1 and 3.2, gears 3.3-3.6 and rollers 4.1-44 described in the first paragraph on page 5 of appellant’s original specification or the last paragraph on page 7 of appellant’s substitute specification filed on July 21, 2000.

Fourth, in the same vein of arguments, appellant avers that Andronis’ element 15 appears to be linearly fixed to elements 14 and 38/44, therefore, element 15 is not movable in a first direction

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with respect to element 38 in Andronis. Appellant overlooks the fact that the element 15 is also fixed to the lever 6, consequently, the element 15 is moved with the lever 6.

Fifth, appellant concludes that: (a) elements 38/44 appear to be movable with respect to elements 39-42 in one direction; (b) element 15 appears to be movable with respect to elements 38/44, but not in the same direction; and (c) therefore, all of elements 15 and 39-42 of Andronis cannot be similar to the louver guide of claim 36. However, Fig. 4 of Andronis shows that the lever 6 is movable in multiple directions including the perpendicular first and second directions (*i.e.*, longitudinal and transverse directions) as seen in the Exhibit. Common sense dictates that when the lever is moved, the elements 15 and 39-42 of Andronis are moved therewith. Indeed, this fact is explained by Andronis in line 9 *et seq.* on page 3 of the translation as seen, *e.g.*, by the sentence "Owing to the design with the support element, compensation sleeve and selection lever sleeve, a simple, smooth shifting with *simultaneous longitudinal and transverse displacement of the slot cover element is possible* between the selection lever shaft and the slot cover element" on page 4 of the translation.

Sixth, appellant contends that claim 36 sets forth that the louver guide is movably connected to the cover in a second direction. As explained above, the fact that the slot cover element or the louver 3 of Andronis is displaced in the second (transverse direction) is explicitly described. Since the guide elements 14, 15, 38-46 are connected to the louver 3 as shown in Fig. 4 of Andronis and claimed in claims 1, 9, and 11 of Andronis (see the translation), thus, when the louver 3 is moved, the elements 14, 15, 38-46 are inherently moved therewith in the same manner as appellant's guide.

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Seventh, appellant contends that page 7 of the translation does not describe that the elements 39-42 being movable with respect to a cover. Appellant ignores the fact that the last paragraph on page 7 of the translation describes and claim 11 of Andronis claims that the slot cover elements 4, 20, 38, 44 and the guide elements 39-42 are integrated in a module that can be inserted as *a preassembled module unit*. Since the elements 39-42 are formed as a module unit with the louver 3, 4, 20, 38, 44, they move together as a unit relative to the cover 2.

Eight, appellant asserts that the phrase "longitudinal shifting path 14" on page 7 of the translation appears to be incorrect. Although it may be incorrect to appellant, one having ordinary skill in the art would recognize that it is correct because the elements 14 and 15 of Andronis form a universal joint, consequently, the lever 6 can move in multiple direction including the longitudinal direction. Since the louver 3, 4, 20, 38, 44 is connected to the lever, and since the elements 39-42 are formed as a module unit with the louver 3, 4, 20, 38, 44, therefore, when the lever 6 is moved, all of the elements 3, 4, 20, 38, 44, 39-42 are moved therewith as a single module.

Ninth, appellant states the page 3 of the translation describes that the guide elements are preferably designed integrally with the cowling. This does not lead a person away from making the guide elements movably connected to the cover because the cowling and the cover are different structural elements.

Tenth, appellant finds no indication in Andronis that movement of elements 6, 14, 15, or 16 requires that the other elements 39-42 are also moved therewith. It is well settled that similar structures would behave similarly. *In re King*, 231 USPQ 136 (CAFC 1986) and *In re Merck & Co.*,

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Inc., 231 USPQ 375 (CAFC 1986). Andronis expressly claims that these elements are formed as a module in the same manner as appellant's module shown in appellant's Figs. 6 and 7, *a fortiori*, all of the elements of Andronis' module move together similarly.

Eleventh, appellant admits in the third paragraph on page 9 of the Brief that claim 36 has been purposely written to broadly cover the connection described in the drawings and specification, and equivalent thereof. The examiner is mindful that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case, appellant's broad claims fail to provide patentable distinguishing structures over Andronis.

Twelfth, appellant contends on page 10 of the Brief that the portions of Andronis which are related to Figs. 4-7 are sparse. The examiner respectfully submits that Andronis sufficiently describes Figs. 4-7 as seen on page 3 *et seq.* of the translation and Andronis' claims 1-11. In addition, the Court has long emphasized that the reference does not need to provide explanation about what artisan would know as evidenced by standard text book. *In re Opprecht*, 12 USPQ2d 1235 (CAFC 1989).

Thirteenth, appellant argues about Andronis' Fig. 3. Nevertheless, the instant Fig. 3 is not used in the rejection, appellant's arguments about Andronis' Fig. 3 are immaterial.

Finally, appellant asserts that appellant does not set forth an intended use or a mode of operation of the device, but the type of connection between the louver guide and the cover plate. It is noted that the features upon which applicant relies (*i.e.*, the type of connection between the louver guide and the cover plate) are not recited in the rejected claim 36. Although the claims are

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interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns, supra*. Moreover, the examiner fully agrees with *In re Luck* cited by the appellant that to the extent any process limitations *distinguish* a product over the prior art, such process limitations must be given the same consideration as traditional product characteristics. The process limitations in the instant case *do not distinguish* the claimed product over the prior art even though these process limitations are given the same consideration.

Claim 37

Appellant argues that: (a) claim 37 has a typographical error in that the dependency from claim A was typed when it should have been typed as claim 36; and (b) the rejection appears to understand this because the rejection states that Andronis has first and second directions in a plane.

The examiner is mindful that “an essential purpose of patent examination is to fashion claims that are *precise, clear, correct, and unambiguous*. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz* at 1322 in 13 USPQ2d 320 (CAFC 1989).

In the case *sub judice*, claim 37 is unclear or ambiguous. The examiner has to guess the scope of claim 37. To avoid piecemeal prosecution, the examiner applies the art rejection in claim 37 pursuant to MPEP 2173.06. The instant art rejection does not preempt the vagueness of claim 37 since the art rejection and indefiniteness rejection are different statutory rejections.

Claim 18

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Appellant reiterates the same lines of arguments for claim 36 in claim 18. The examiner's response for claim 36 is similarly applied herein.

Claim 26

Appellant avers that the element 44 of Andronis is a flexible band, thus, it is not similar to a support structure of a louver guide. The examiner respectfully submits that claim 26 does *not* specifically call for a rigid support structure, *a fortiori*, claim 26 is “fully met” by the flexible support structure 44 of Andronis.

Claim 27

Appellant contends that claim 27 calls for an elastic louver portion having elastic properties. The examiner respectfully submits that appellant's drawings do not show the claimed elastic louver portion. Therefore, it is unclear as to how appellant makes/uses the elastic portion. On the other hand, Andronis teaches on page 7 of the translation that the band 44 is flexible. The *Merriam Webster's Collegiate Dictionary* defines “flexible” as being a synonym of “elastic.” Thus, the flexible or elastic portion such as the band 44, 38, 3 of Andronis corresponds to appellant's claimed elastic portion by definition.

Claim 29

The examiner's response for claim 26 is similarly applied herein.

2. Whether claims 18-30, 32, 33, and 35-38 are indefinite?

First, appellant contends that the actual direction of the first direction as set forth in claim 36 is immaterial. It is well settled that the claim has to be read in light of the specification, drawings, and

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prosecution history. See *Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc.*, 230 USPQ 416 (CAFC 1986). More important, appellant specifically claims the first direction, thus, it is material. In the present condition of the claims, appellant's specification does not have an antecedent basis for the term "a first direction" and drawings do not show the first direction, thus, the claim is unclear and ambiguous. Similar response is applied to the term "a second direction."

Second, appellant argues that in the embodiment of Figs. 6 and 7, the second direction is substantially between the lower left and the upper right, and the first direction is between the lower right and the upper left. However, appellant's arguments are unsupported by the specification. In fact, the specification does not describe as such. One has to guess appellant's directions based on Figs. 6 and 7, consequently, appellant fails to fashion the claims that are precise, clear, correct, and unambiguous. *In re Zletz, supra*.

Third, appellant's position is that a person of ordinary skill would be able to place an elastic portion in a band based on the teaching of claim 27 and lines 14-17 on page 4 of appellant's substitute specification, therefore, claim 27 is sufficiently described to be understandable to a person of ordinary skill. The examiner respectfully submits that the issue is not whether one would be able to place an elastic portion in a band based on the teaching of claim 27 and specification. The issue is whether the claim specifically points out the essential structural cooperative relationships of the elastic portion and the louver plus the other structural elements in the claims. See MPEP § 2172.01. Appellant's drawings do not show the claimed elastic portion as required under 37 CFR 1.83, thus, one cannot clearly and unambiguously interpret the elastic portion based on the drawings.

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Fourth, appellant similarly contends that claim 33 is definite since a person of ordinary skill in the art would be readily able to sense position of a selector lever given the teaching of the present invention to use Hall sensors and permanent magnets. The CAFC in *Lockwood v. American Airlines Inc.*, 41 USPQ2d 1961 (CAFC 1997) and *Martin v. Mayer*, 3 USPQ2d 1333, 1337 (CAFC 1987) has emphasized that the issue is not whether one skilled in the art would have been able to make the claimed kinematics using knowledge of the art, but rather did appellant's application sufficiently describe as to how appellant makes/uses the claimed Hall sensors and permanent magnets. Section 112 does not require that the specification contains that which is known to those skilled in the art, but it does require specificity as to the claimed limitations. It is "*not* a question of whether one skilled in the art *might* be able to construct the patentee's device from the teachings of the disclosure . . . Rather, it is a question whether the application necessarily discloses that particular device." *Jepson v. Coleman*, 136 USPQ 647, 649-50 (CCPA 1963)(emphasis in original). Returning to the case at hand, appellant's written specification and drawings do not describe the interstructural relationship among the Hall sensors, the permanent magnets, and the other claimed elements, therefore, the claims cannot be interpreted unambiguously in light of the specification, drawings, and prosecution history.

Finally, appellant contends that claims 37 and 38 are definite since: (a) appellant now confirms that these claims are dependent upon claim 36; (b) claim 37 has been considered, searched, and rejected, and claim 38 has been indicated to be allowed. The examiner respectfully submits that 37 CFR 1.111 requires that appellant's reply to an Office action must distinctly and specifically point out the supposed errors in the examiner's action and must present arguments pointing out the specific

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distinctions believed to render the claims, *including any newly added claims*, patentable over any applied references. Appellant did not comply with these requirements in the Amendment filed on December 26, 2001. To avoid piecemeal prosecution, the examiner had to second guess the scope of appellant's claims 37 and 38 when the examiner applied the art rejection. Appellant now positively claims that claims 37 and 38 are dependent upon claim 36. The new dependency of claims 37 and 38 now requires further consideration, *inter alia*, under 35 USC 112 and/or search under 35 USC 102 or 103. To allow the entry of appellant's new dependency of claims 37 and 38 at this stage of appeal would: (a) be a *de facto* waiver of appellant's affirmative duty under 37 CFR 1.111; (b) be grossly unfair to the other applicants who timely and fully comply with 37 CFR 1.111; and (c) encourage the practice of prolonging prosecution, *i.e.*, undermine the goal of compact prosecution in accordance with MPEP 707.07(g).

For the reasons set forth above, the Board is respectfully requested to affirm the rejection based on Andronis and 35 USC 112, second paragraph.

3. Whether appellant's claims 18-30, 32, 33, and 35-38 are unpatentable under 35 USC 112, first paragraph?

First, appellant averred that appellant's disclosure was adequate with respect to the claimed feature "kinematics" in claim 18. This argument has been responded in claim 33 above. See *Lockwood v. American Airlines Inc.* and *Martin v. Mayer, supra*.

Second, in the same vein of arguments, appellant subjectively concludes that one having ordinary skill in the art would be led to believe that appellant had possession of the elastic louver

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portion in claim 27, the signal transmitters and receivers in claims 32 and 35, the permanent magnets and Hall sensors in claim 33, *etc.* However, appellant's statements are unsupported by any anecdotal data or evidence, such as, affidavits, declarations, cited patents, and/or publications, *etc.* The examiner is mindful that an expert's opinion on the ultimate legal issue must be supported by something more than a conclusory statement. *In re Buchner*, 18 USPQ2d 1331, 1332 (CAFC 1991). In the absence of factual data, the Court has long emphasized the rule that the Patent Office will reject a patent application that fails to satisfy *any* one of the statutory requirements. See *Gentry Gallery, Inc. v. Berkline Corp.*, 45 USPQ2d 1948 (CAFC 1498)(patent invalid for failing to comply with the written description requirement), and *Enzo Biochem, Inc. v. Calgene, Inc.*, 52 USPQ2d 1129 (CAFC 1999)(patent invalid because the claims were not enabled).

For the above reasons, it is believed that the rejections under this ground of 35 USC 112, first paragraph, should be sustained.


With respect to appellant's arguments regarding appellant's issues 4-6, these issues are petitionable matter, thus, they are not addressed herein.

Respectfully submitted,



Vinh T. Luong
Primary Examiner

Conferees on November 20, 2002:

Supervisory of Patent Examiners David Bucci 

and Primary Examiner Lennard Footland 